

Notice of Allowability

Application No.

09/647,479

Examiner

Callie E. Shosho

Applicant(s)

MEYRICK ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 9/15/03.
2. ☒ The allowed claim(s) is/are 3-8 and 11-14.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No. _____.
- (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
- (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- 1 ☐ Notice of References Cited (PTO-892)
- 2 ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3 ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____
- 4 ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- 5 ☐ Notice of Informal Patent Application (PTO-152)
- 6 ☐ Interview Summary (PTO-413), Paper No. _____
- 7 ☐ Examiner's Amendment/Comment
- 8 ☒ Examiner's Statement of Reasons for Allowance
- 9 ☐ Other _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Statement of Reasons for Allowance

1. The present claims are allowable over the “closest” prior art EP 732381 and Lent et al. (U.S. 5,837,042) for the following reasons:

EP 732381 discloses ink jet ink comprising water-dissipatable polyurethane, water, colorant, water-miscible solvent, and water-immiscible solvent.

However, there is no disclosure or suggestion in EP 732381 of the weight average molecular weight of the polyurethane. Further, while EP 732381 discloses list of solvents that includes both water-miscible solvents and water-immiscible solvents, there is no requirement in EP 732381 to use mixture of water-miscible solvent and water-immiscible solvent as required in all the present claims.

In order to meet the requirement regarding the weight average molecular weight of the polyurethane, examiner argued, on the one hand, that given the relationship between molecular weight and viscosity, it therefore would have been obvious to one of ordinary skill in the art to choose polyurethane with molecular weight, including that presently claimed, in order to control the viscosity of the ink. However, there is no disclosure in EP 732381 of the viscosity of the ink and no suggestion or guidance to choose polyurethane with weight average molecular weight less than 25,000 as required in the present claims. Further, as set forth on pages 2-3 of the amendment filed 9/15/03, given that EP 732381 discloses crosslinked gel fine particles, the molecular weight of the polyurethane in the gel particles would not correlate to the viscosity of the inks containing the gel particles.

On the other hand, EP 732381 was combined with Lent et al., which discloses ink jet ink comprising weight average molecular weight of 4000-12,000. However, there is no disclosure in

Lent et al. that the polyurethane is water-dissipatable as required in the present claims. Further, there is no disclosure that the ink comprises water-immiscible solvent as required in the present claims.

Thus, it is clear that EP 732381 and Lent et al., either alone or in combination, do not disclose or suggest the present invention.

In light of the above, it is clear that the rejections of record are untenable and so, the present claims are passed to issue.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

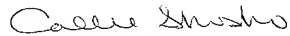
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
12/8/03